

AN INTRODUCTION TO PASSING OFF

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DEFINITION

- Passing off, in relation to goods, can be said to be the use of by a person on his own goods of a mark or get- up belonging to another person with the intention of passing off the goods as being those of that other person.
(David Bainbridge).
- ‘Get- up’ include the appearance of goods, packaging or the general manner in which goods are displayed, advertised or sold and may be referred to as Trade- dress.

ORIGIN AND RELEVANCE

- The tort of passing off is of common law origin. It may be traced, for example, to the old law of *slander of title*.
- It was developed as an attempt to prevent the deceptive use of marks and signs used to distinguish the goods and services of one undertaking from those of others, often competitors.
- It is closely related to trademarks, unfair competition and the tort of malicious falsehood (provides a remedy against the disparagement of one trader's goods by others, often competitors) and may overlap in certain circumstances.
- Standard of recognition and enforcement varies in jurisdictions [civil law countries do not recognise “passing off” as a Cause of Action].
- Largely recognised in Commonwealth Countries.

DISTINCTION

REGISTRATION

The major distinguishing factor between an action brought under the tort of passing off and an infringement in trademarks is the registration of a trademark. In some jurisdictions, cases on trademark infringement often include claims for passing off.

REQUIREMENTS

RECKITT & COLMAN PRODUCTS LTD V BORDEN INC & ORS [1990] 1
WLR 59

1. GOODWILL

Goodwill is the essence of the tort of passing off. The recognition by consumers or a class of consumers, of certain attributes such as quality or value for money, associated with a trader's goods or services. It is the impression an undertaking leaves on its consumer(s) over its goods and/or services.

Without goodwill, where goodwill is challenged, a passing off action is bound to fail.

REQUIREMENTS

2. MISREPRESENTATION

The use, with or without bad faith, of a trade name, trade dress or get-up, in such a manner as to occasion confusion amongst potential consumers as to the origin of the goods and/or services. This can take place in various forms.



REQUIREMENTS

3. DAMAGES

The misrepresentation must be evinced to cause harm in the present or near future; usually damage to sales or business activity of the undertaking. This may also be damage to the goodwill of an undertaking or other financial losses.

- Erven Warnink BV v J Townend & Sons (Hull) Ltd [1979] AC 731
- Taittinger SA v Allbev Ltd [1993] FSR 641

DEFENCES

- Evidence of first and continuous use (Section 7, Cap T13 LFN 2004)
- Registration
- *Bona fide* use of own name (Section 8, Cap T13 LFN 2004)

Note that applicable defence(s) will be governed by the specific laws governing passing off actions in a jurisdiction.

THANK YOU

Additional reading material

<https://scholars.law.unlv.edu/cgi/viewcontent.cgi?article=1806&context=facpub>